

Response dated 08/08/2005
Reply to Office Action of 03/07/2005

Application No. 109/995,649

REMARKS

The Office Action of March 7, 2005 has been reviewed and the comments therein were carefully considered. Claims 1, 3-16, 18-32, 34-40, 42-45, and 48 are pending in this application. Claims 2, 17, 33, 41 and 46-47 are canceled. Claims 1, 4, 10, 12-16 are rejected as being unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 6,195,004 to Leonowich ("Leonowich") in view of U.S. Patent No. 5,797,125 to Hirohama ("Hirohama"). Claims 33 and 48 were rejected as being unpatentable under 35 U.S.C. § 103(a) over Leonowich in view of U.S. Patent No. 6,404,442 to Hilpert ("Hilpert"). Claims 2-3, 6-9, 11, 17-31, 34-35, 38, 42-46 were rejected as being unpatentable under 35 U.S.C. § 103(a) over Leonowich in view of Hirohama in further view of Hilpert. Claims 5, 32, 36-37 and 39-41 were objected to as depending from rejected claims but were deemed allowable if rewritten in independent form to include the base limitations and any intervening limitations. Applicant respectfully traverses the rejection of the pending claims in light of the above amendments and the following remarks.

Canceled Claims

Claims 2, 17, 33, 41, 46 and 47 are canceled. Accordingly, the rejection of any canceled claim is considered moot. In the instances where features of the canceled claims have been incorporated into a base claim, the rejection of the canceled claim will be addressed with respect to the base claim.

Amended Claims

Claims 1, 16 and 42 were amended to incorporate limitations of claims that depend from them. Claim 34 was rewritten in independent form to include the limitations of the base claim 33.

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Claim 48 has been amended. Support for the amendment is at least four d on paragraphs 26-30 of the application as filed, thus no new matter has been added.

Claim Rejections Under 35 U.S.C. §103 – Leonowich & Hirohama

Independent claims 1 and 16 have been amended to recite limitations of dependent claims 2 and 17, respectively. Accordingly, the rejection of claims 1 and 16, along with any rejected claims depending from claims 1 and 16 will be addressed below.

Claim Rejections Under 35 U.S.C. §103 – Leonowich & Hilpert

Claim 33 has been canceled, thus mooting the rejection of claim 33.

Claim 48 has been amended. Applicants respectfully submit the combination of Leonowich and Hilpert, alone or in combination with any other reference of record, fail to disclose, suggest or teach all the limitations of amended claim 48. Accordingly, claim 48 is believed to be in condition for allowance and notification of same is respectfully requested.

Claim Rejections Under 35 U.S.C. §103 – Leonowich & Hirohama & Hilpert

Claims 2-3, 6-9, 11, 17-31, 34-35, 38 and 42-46 were rejected as being unpatentable over Leonowich in view of Hirohama in further view of Hilpert. Claim 1 has been amended to include the limitations previously recited in claim 2, thus the rejection of claim 2 will be addressed with respect to claim 1. Similarly, claim 16 was amended to include the limitation recited in claim 17, thus the rejection of claim 17 will be addressed with respect to claim 16.

Before addressing the substance of the rejection, the Applicants would like to respectfully remind the Examiner that a *prima facie* 103 rejection requires a showing of three things: disclosure of all the limitations; some expectation of success, and motivation to combine. See MPEP 706.02(j) ("To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must

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be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. [Third], the prior art reference[s] ... must teach or suggest all the claim limitations."). Regarding the motivation to combine, it is improper to create this motivation based on the Applicant's disclosure rather than what is known in the referenced teachings. Regarding the disclosure of all the claim limitations, it is insufficient to suggest that something disclosed in a reference teaching may be modified to reach the present invention because this necessarily means the reference did not disclose the limitation. These types of arguments indicate the rejection is based on improper hindsight reconstruction cautioned against by the US Court of Appeals for the Federal Circuit. *See In re Deuel*, 51 F.3d 1552, 1558 (Fed. Cir. 1995) (reversing a Board of Appeals rejection of a claim for obviousness because the rejection was based on speculation and improper hindsight construction without a proper showing of motivation in the cited references)

Turning to the merits of the rejection of independent claim 1, the Office Action admits that Leonowich fails to disclose "prioritizing ... based on at least one context value." Applicants agree that Leonowich fails to disclose, suggest or teach such a feature. The Office Action suggests, however, that this deficiency is corrected by the addition of Hirohama. The Office Action appears to be suggesting that this feature is inherently found in Hirohama because it teaches a mobile terminal that "responds according to its location relative to different guide areas and also the languages needed by the individual users."

Assuming for purpose of discussion that the Office Action is correct, this does not correct the deficiency in Leonowich. Hirohama teaches a mobile device with an infrared receiver that may receive a single signal from a booth to indicate which booth the user is in and this signal may initiate

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a prerecorded message stored within the mobile terminal that is related to the both. (Hirohama, C. 3, L. 1 – C. 4, L. 21). Hirohama simply does not disclose anything related to “prioritizing ... based on at least one context value.” Prioritizing requires the plurality of message received, as recited in claim 1, to be ordered in some manner. Hirohama receives a message and responds accordingly based on a user preference; therefore Hirohama has no need to prioritize. Nor does Hirohama actually discuss any type of prioritizing. Therefore, Hirohama cannot be fair / read to correct the deficiency in Leonowich.

Furthermore, there is no motivation to modify Leonowich to provide any priority in the first place. Leonowich provides an indication when an activity happens, such as the dishwasher finishing a wash cycle or the garage door opening. If two activities happen, the user would want to be notified of both activities and there is no suggestion in Leonowich or any other reference of record other than the Applicant’s disclosure, that these notifications could be somehow prioritized. Therefore, the combination of Leonowich and Hirohama is improper and, even if proper, fails to disclose the “prioritizing ... based on at least one context value” as recited in independent claim 1.

Assuming they can be combined, the Office Action admits that the combination of Leonowich and Hirohama fails to disclose the “receiving a plurality of messages from at least one message source, each message associated with at least one associated auditory icon and at least one associated visual icon” as recited in claim 1. Applicants agree that the combination fails to disclose, suggest or teach “receiving a plurality of messages from at least one message source, each message associated with at least one associated auditory icon and at least one associated visual icon.” Indeed, neither Leonowich nor Hirohama include a display. Office Action suggests, however, that Hilpert corrects this deficiency because “sounds are projected or rendered in space surrounding a computer

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system to provide information concerning various aspects of information displayed on the computer system display screen."

Assuming the Office Action is correct, this still fails to disclose the limitation recited in independent claim 1. As a logical matter, Applicants fail to see how the projection of sounds in space to represent images on a graphical display can be equated with "receiving a plurality of messages from at least one message source, each message associated with at least one associated auditory icon and at least one associated visual icon" as recited in claim 1. In addition, the Office Action has not pointed to any part of Hilpert as disclosing "receiving a plurality of messages from at least one message source, each message associated with at least one associated auditory icon and at least one associated visual icon." Thus, the Office Action has not provided any support for its contention that Hilpert somehow corrects the deficiency in Leonowich and Hirohama.

Nor is there any motivation to combine these three references. The Office Action suggests that the motivation for combining Hilpert with Leonowich and Hirohama is "to aid the Leonowich user in responding to the 'messages' that are transmitted to device 42." This reasoning is, at best, improper hindsight based motivation. First, there is nothing in any of the references that actually discloses the motivation that the Office Action has put forth. If the Examiner disagrees with this point, the Applicants respectfully request that the Examiner point out the location of the support for this motivation. Nor does the teaching of Hilpert actually provide any aid to the user of Leonowich. Leonowich provides notification with unique sounds when an activity takes place. There is nothing in Leonowich or Hilpert or any of the references of record that suggest a display would somehow help this process. A unique audible alert that the activity has taken place is all that is needed. In addition, Leonowich expressly explains that visual icons are unsuitable:

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The same benefit cannot be obtained in a visual indicator environment because an operator has to repeatedly focus attention on a device to look for an indication of a completed task. Also, visual indicators are rendered useless once the operator leaves the room containing the indicator.

(Leonowich, C. 1, L. 36-41). Thus, the Office Action's alleged motivation is in direct conflict with what the references teach and this suggested motivation plainly cannot be found in Leonowich.

In summary, no proper motivation exists to combine the references. Even if the references were somehow combinable, they still do not disclose all the features of independent claim 1. Accordingly, Applicants respectfully submit that the Office Action has not provided adequate support for a *prima facie* case of obviousness with regard to claim 1.

Claims 3-4 and 6-15 depend from claim 1 and are non-obvious for at least the above reasons and for the additional limitations recited therein. For example, claim 3 recites "displaying the visual icon using a display format that is enlarged in relation to other icons in the display." The Office Action suggests that the first icon in Hilpert could be enlarged simply by its static specification. Thus, the Office Action is admitting that Hilpert does not actually disclose this limitation. Speculation as to what is possible does not support a *prima facie* case of obviousness. *See* MPEP 706.02(j) ("To establish a *prima facie* case of obviousness, three basic criteria must be met. ... [Third], the prior art reference[s] ... must teach or suggest all the claim limitations.")

All other pending claims rejected by the above combination recite a feature similar to the limitation discussed above with respect to independent claim 1 and therefore, for at least the reasons discussed with regard to claim 1, the remaining pending claims are non-obvious over the references of record.

Accordingly, withdrawal of this ground of rejection is respectfully requested.

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Claim Objections:

Claims 5, 32, 36-37 and 39-41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. While agreeing that these claims are allowable, for the reasons stated above, the Applicant believes that all of the pending claims are in condition for allowance.

CONCLUSION

The Applicant respectfully submits that the instant application is in condition for allowance. Should the Examiner believe that a conversation with Applicant's representative would be useful in the prosecution of this case, the Examiner is invited and encouraged to call Applicant's representative.

Respectfully submitted,

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